

Docket No.: 03-247

REMARKS

Reconsideration of this application and withdrawal of the rejections set forth in the Office Action mailed January 25, 2006, is requested in view of the amendments above and the following remarks. Prior to this amendment, claims 1-3, 6-8, 10-13, 18-21, 24 and 25 were pending and at issue in this application. Claims 4, 5, 9, 14-17, 22, 23 and 26 were withdrawn from consideration pursuant to a restriction requirement and an election by applicant. Claims 1, 18 and 20 are generic. All of these withdrawn claims depend from a generic claim, or an intervening claim, and the restriction claim is to be withdrawn as to each claim upon allowance of a respective generic claim. Claims 1, 6, 18, 20, 23 and 24 have been amended herein. New claims 27-36 have been added. New claims 27-36 are also generic to, and/or read upon, the elected species (i.e. a device having the heating material embedded). No new matter has been added.

I. CLAIM REJECTIONS UNDER 35 U.S.C. § 102

Claims 1-3 and 8 stand rejected under 35 U.S.C. § 102, as being anticipated by Engelson (U.S. Patent No. 5,749,894), and claims 1-3, 7, 10-13, 18-21 and 25 were rejected under 35 U.S.C. § 102, as being anticipated by Ken et al. (U.S. Patent No. 5,853,418). Applicants submit that the § 102 rejections should be withdrawn because neither Engelson nor Ken et al. disclose or teach the claimed invention for a vaso-occlusive device comprising a first material which may be heated by application of a source of energy external to a patient's body, and a bioactive agent which is released or activated directly or indirectly upon such heating of the first material. In order to sustain a rejection for anticipation, each and every element of the claim must be found, either expressly or inherently, in a single prior art reference, and arranged as required by the claim. *See* MPEP § 2131; *In re Bond*, 910F.2d 831 (Fed. Cir. 1990).

Docket No.: 03-247

Independent claims 1, 18 and 20 have been amended herein to recite a bioactive agent that is activated or released upon the heating of the first material (or ferrous material, as the case may be). None of the cited prior art teaches or discloses such a device. Claim 2-17, 19, and 21-26 depend from one of claims 1, 18 or 20, or an intervening claim, and are therefore not anticipated for at least the same reasons.

As to the new method claims 27-36, the cited prior art fails to teach or disclose a method of deploying a vaso-occlusive device in the vasculature which includes the step of heating said first material by application of a source of energy external to the patient's body. The Examiner fails to point to any teaching or suggestion in the cited prior art to heat a vaso-occlusive device using a source of energy external to the patient's body, as claimed in the present invention. Accordingly, claims 27-36 are not anticipated by the cited prior art.

II. CLAIM REJECTIONS UNDER 35 U.S.C. § 103

In the Office Action, claims 6 and 24 were rejected under 35 U.S.C. 103(a) as being obvious over Ken et al. in view of Bose et al. (U.S. Patent No.6,605,111 B2). Claims 6 and 24 are not obvious over the cited prior art because there is no teaching or suggestion to provide a vaso-occlusive device comprising a first material which may be heated by application of a source of energy external to a patient's body, and a bioactive agent which is released or activated directly or indirectly upon such heating of the first material.

In contrast to the present invention, Bose et al. discloses incorporating a bioactive agent into a polymer which is released when the polymer biodegrades, not by the heating of the device using a source of energy external to a patient's body. Biodegradation is the decomposition of an organic material. Bose et al. is absolutely silent as to the release of the bioactive reagent, or biodegradation,

Docket No.: 03-247

by heating the device using a source of energy external to the patient's body. Accordingly, the cited prior art does not teach or disclose a bioactive agent which is released or activated by the heating of the device with an energy source external to the patient's body. Moreover, there is no teaching or suggestion to provide a configuration in which a bioactive reagent is released or activated by heating, directly or indirectly, the bioactive reagent itself, or a material in which the bioactive reagent is contained.

Accordingly, claims 6 and 24, and amended claims 1, 18 and 20, patentably distinguish over the cited prior art and the obviousness rejections should be withdrawn.

CONCLUSION

Any claim amendments which are not specifically discussed in the above remarks are not made for reasons of patentability, do not affect the scope of the claims, and it is respectfully submitted that the claims satisfy the statutory requirements for patentability without the entry of such amendments. These amendments have only been made to increase claim readability, to improve grammar, or to reduce the time and effort required of those in the art to clearly understand the scope of the claim language.


In view of the foregoing amendments and remarks, Applicants respectfully submit that all of the examiner's rejections have been overcome. Accordingly, allowance is earnestly solicited. If the examiner feels that a telephone interview could expedite resolution of any remaining issues, the

Docket No.: 03-247

examiner is encouraged to contact Applicants' undersigned representative at the phone number listed below.

Respectfully submitted,
VISTA IP LAW GROUP LLP

Dated: 6/9/06

By: 
David T. Burse
Reg. No. 37,104

Customer Number
41696
PATENT TRADEMARK OFFICE

VISTA IP LAW GROUP LLP
12930 Saratoga Avenue, Suite D-2
Saratoga, CA 95070
Phone (408) 777-2905
Fax (408) 877-1662